UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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R2002-164

AUG 1 2 2002

In re

: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)

## MEMORANDUM AND ORDER

(petitioner) petitions for regrading his-her answers to question 35 of the morning section and questions 7, 12, 24, 27, 32 and 33 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

## BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On January 28, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made

regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

## OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a

question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional one point for afternoon question 12. Accordingly, petitioner has been granted an additional one point on the Examination. No credit has been awarded for morning question 35 and afternoon questions 7, 24, 27, 32 and 33. Petitioner's arguments for these questions are addressed individually below.

Morning question 35 reads as follows:

35. During their period of courtship, Amy and Pierre invented and actually reduced to practice an improved frying pan, wherein the sides and integral handle are formed from a metal having a low coefficient of conductivity, and a base providing the cooking surface formed from a metal having a high coefficient of conductivity. While the basic concept was old in the art, Amy's concept was to sandwich a layer of aluminum between layers of copper, while Pierre's concept was to sandwich a layer of copper between layers of aluminum. Accordingly, acting as pro se joint inventors, they filed a nonprovisional patent application in the USPTO on January 10, 2001, along with a proper nonpublication request. The application disclosed both Amy's and Pierre's concepts in the specification, and contained three independent claims: claim 1 was generic to the two concepts; claim 2 was directed to Amy's concept, and claim 3 was directed to Pierre's concept. Thereafter, Amy and Pierre had a "falling out" and Pierre returned to his home in France where he filed a corresponding patent application in the French Patent Office on January 31, 2001. Pierre was completely unaware of any obligation to inform the USPTO of the French application. Amy first learned of Pierre's application in the French Patent Office on October 10, 2001. Once Amy learns of the French application, which of the following actions should she take which accords with proper USPTO practice and procedure and which is in her best interest?

(A) Immediately notify the USPTO of the filing of the corresponding application in the French Patent Office.

(B) Promptly submit a request to the USPTO under Amy's signature to rescind the nonpublication request.

(C) File an amendment under Amy's signature deleting claim 3 and requesting that Pierre's name be deleted as an inventor on the ground that he is no t an inventor of the invention claimed.

(D) Promptly file a document, jointly signed with Pierre, giving notice to the USPTO of the filing of the corresponding application in the French Patent Office and showing that any delay in giving the notice was unintentional.

(E) File an application for a reissue patent that is accompanied by an amendment paper with proper markings deleting Pierre's concept from the specification and a statement canceling claims 1 and 3.

The model answer is selection (D).

(D) is correct because 35 U.S.C. § 122(b)(2)(B)(iii) indicates that such action may avoid abandonment of the application. (A) is wrong because the action is being taken more than 45 days after filing of the corresponding application in the French Patent Office and thus

will not avoid abandonment of the application. 35 U.S.C. § 122(b)(2)(B)(iii). (B) is wrong because 37 CFR 1.213(a)(4) requires that the request be signed in compliance with 37 CFR 1.33(b)(4), which requires that all applicants sign. (C) is wrong because such action will not avoid abandonment of the application pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). (E) is wrong because Amy's application has not issued as a patent, and reissue relates only to applications that have issued as patents.

Petitioner selected answer (E) as the correct answer. The petitioner argues that none of the answers are most correct. The petitioner contends that since Mary and Pierre had a "falling out" that she will not be able to get Pierre's signature. Petitioner argues that the correct answer should have been that she "should request" that Pierre jointly sign the document. Therefore petitioner argues that the question is flawed.

The petitioner's arguments have been fully considered but are not persuasive. Petitioner is reminded that the instructions for the examination stated to not assume facts not stated. The facts in the question do not state that Pierre will refuse to sign the required petition. In addition, Amy's application has not issued as a patent, and reissue relates only to applications that have issued as patents. In addition, by following the action in answer (E), Amy may not be able to file a petition and state that the delay was "unintentional." A requirement for such a petition is that the entire delay from the date the notification was due under 35 U.S.C. § 122(b)(2)(B)(iii) to the date a grantable petition was filed was unintentional. See 37 CFR 1.137(b) and (f). Therefore, if Amy intentionally delays filing the petition, as suggested by petitioner, she might not be able to properly file the petition at a later time. Answer (D) is the only answer that will result in the revival of Amy's application. Accordingly, answer (D) is correct and petitioner's answer (E) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 7 reads as follows:

7. Izzy decides one day that the hydrogen fuel cell research in which he is engaged shows great potential and retains the services of a patent law firm. A patent application is promptly prepared and filed in the USPTO disclosing and claiming a hydrogen fuel cell wherein the electrodes employed to catalyze the hydrogen gas into positive ions and negative ions consist of a platinum catalyst. The original claims are fully supported by the application as filed. Two preliminary amendments are submitted after the original filing, but prior to initial examination. In the first preliminary amendment, the specification, but not the claims, is amended to recite that the electrodes may consist of a niobium catalyst. In the second preliminary amendment, the specification and the claims are amended to recite that the electrodes may consist of an iridium catalyst. In the first Office action, the examiner determined that both amendments involve new matter and required their cancellation. In addition, the examiner rejected all the claims under 35

U.S.C. § 112, first paragraph on the ground that they recited elements without support in the original disclosure. Ultimately, the examiner issued a Final Rejection on the same basis. Based upon proper USPTO practice and procedure, which of the following is correct?

(A) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by appeal.

(B) Review of the determination that both the first preliminary amendment and the second preliminary amendment contain new matter is by petition.

(C) Review of the determination that the first preliminary amendment contains new matter is by appeal, and review of the determination that the second preliminary amendment contains new matter is by petition.

(D) Review of the determination that the first preliminary amendment contains new matter is by petition, and review of the determination that the second preliminary amendment contains new matter is by appeal.

(E) (A), (B), (C), and (D).

The model answer is selection (D).

MPEP § 608.04(c) ("Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one."); see, also, MPEP § 706.03(o) ("In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. § 112, first paragraph."). (A), (B), and (C) are incorrect. (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

The petitioner argues that answer (A) is the most correct. The petitioner contends that is possible to read the facts such that the first amendment enlarged the scope of the claims. Petitioner argues that if the amendment added another embodiment to the specification, which was covered by "means for" type language in the claims, then the rejected claims would be based on both amendments. Then both amendments would be appealable and answer (A) is also one of the best answers.

The petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's argument that it is possible that the amendment to the specification might also have added new matter to the claims, if the claims included "means for" type language, the instructions state "[d]o not assume any additional facts

not presented in the questions". There is no mention on "means for" type language in the claims. Therefore, the first amendment did not introduce new matter into the claims. Accordingly, answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 24 reads as follows:
24. Pete wants to file a protest against a patent application filed by a coworker. In the locker room at his place of employment, Pete overheard Sol talking about an application for a golf ball retriever. Pete feels that the invention strongly resembles a golf ball retriever device published in a 1995 edition of Popular Golf magazine. Pete comes to you to file a protest. Pete wants to know if it will be considered by the examiner, and if the applicant (Sol) is required to respond. Pete believes he heard Sol say the application was filed in May 2001, and wonders whether he should include evidence of fraud since Pete believes that his (Pete's) wife may have shown Sol the Popular Golf article. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

(A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.

(B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if:

(1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and
(2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.

(D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes:

(1) a listing of the patents, publications, or other information relied upon;

(2) a concise explanation of the relevance of each listed item;
(3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and
(4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

The model answer is selection (E).

37 CFR 1.291(c). In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. (A) contains portions of the elements of 37 CFR 1.291(a) & (b). (B) contains portions of the elements of 37 CFR 1.291(a). (C) contains portions of the elements of 37 CFR 1.291(a) & (b). (D) contains portions of the elements of 37 CFR 1.291(a) & (b).

Petitioner selected answer (B) as the correct answer. The petitioner argues that none of the answers are most correct, as the question is flawed. The petitioner contends that the question is outside the scope within which the PTO may test, as it raises confidentially and privacy issues. Petitioner also argues that it would be unethical for a practitioner to file a protest without more information. Therefore petitioner argues that the question is flawed and that all answer choices should be given credit.

The petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's argument, the question is not outside the scope in which the PTO may test. Another individual may file a protest, if they believe someone has falsely filed an application. An individual is also permitted to submit references in a protest. See MPEP 1900. Accordingly, answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 27 reads as follows:
27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary's name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean

where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary's name to the § 1.63 declaration and also Sam's name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

(A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.

(B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.

(C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.

(D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.

(E) Sam may sign Mary's name to the declaration since he was authorized by Mary to do so.

The model answer is selection (E).

(E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word "made" implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of 37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(i), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

Petitioner selected answer (A) as the correct answer. The petitioner argues that the PTO's model answer is wrong and thus the question is flawed and that all of the answers should be given credit. Petitioner argues that PTO rules allow someone appointed to look after the affairs of an incompetent or incapacitated person to sign on

behalf of that individual. Petitioner argues that state and federal law support all of this, and that state laws typically go further. Thus Mary would be able to appoint her father, since she could not be reached. Therefore petitioner argues that the question is flawed and that all answer choices should be given credit.

The petitioner's arguments have been fully considered but are not persuasive. State laws regarding powers of attorney do not extend to federal patent law. The controlling federal law is that the inventor or inventors must sign the oath or declaration pursuant 35 U.S.C. §§ 115, 116, 117 and 118. Sections 116-118 describe certain exceptions where another can sign for an inventor, but none of those exceptions apply to the fact pattern in the question. Therefore, Mary could not have properly authorize Sam to sign the declaration on her behalf. Accordingly, answer (E) is the answer that is not in accordance with proper USPTO procedure, and therefore, is the most correct answer to the question.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 32 reads as follows:
32. Which of the following is true?

(A) Once the issue fee has become due, provided an original application has not been pending more than three years, the applicant may request and the Office may grant a request for deferral of payment of the issue fee.

(B) The time period set for the payment of the issue fee is statutory and cannot be extended. However, if payment is not timely made and the delay in making the payment is shown to be unavoidable, upon payment of a fee for delayed payment, it may be accepted as though no abandonment had occurred, but there will be a reduction on the patent term adjustment for the period of abandonment.

(C) Upon written request, a person citing patents and printed publications to the Office that the person believes has a bearing on the patentability of a particular patent, may request that his or her name remain confidential.

(D) To obtain benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is not required to claim priority under 35 U.S.C. § 120 to an earlier filed application.

(E) Each of statements (B) and (C) is true.

The model answer is selection (E).

As to (B), see 35 U.S.C. §§ 151; 154(b)(2)(ii) and (iii); 37 CFR 1.704(c)(3); MPEP § 1306. As to (C) see MPEP §§ 2203 and 2212. As to (D), the claim for priority is not required, as a person may not wish to do so in order to increase the term of his or her patent. As to (A) deferral under 37 CFR 1.103 is not available following the notice of allowance. Since (B) and (C) are correct, (E) is the best answer.

Petitioner selected answer (D) as the correct answer. The petitioner argues that (D) is one of the best answers. The petitioner argues that an applicant doesn't claim domestic priority under 35 U.S.C. § 120, as the statute says you don't get the benefit without a specific reference to the earlier application. You do have to claim priority under 35 U.S.C. § 119. Therefore petitioner argues that (D) should also be given credit.

The petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's argument to obtain the benefit of priority based on an earlier filed patent application, an applicant in a later filed continuation application is required to claim priority under 35 U.S.C. § 120 to the earlier filed application. A priority claim may be obtained under 35 U.S.C. 119(a)-(d) if the earlier application is a foreign application, or under 35 U.S.C. 119(e) if the earlier application is a provisional application. A later filed application cannot be a continuation application to a provisional application nor a foreign application. Answer D states that the later filed is a continuation application, therefore, 35 U.S.C. 119 does not apply. Accordingly, answer (E) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:
The following facts pertain to questions 33 and 34.
Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:
Claim 1. An apparatus for converting solar energy into electrical energy comprising:
(i) a metallic parabolic reflector;
(ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
(iii) an electrical generator coupled to the steam engine.
In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known

by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

(A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

(B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

(C) Traverse the rejection arguing that the examiner does not create a prima facie case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

(D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.

(E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner selected answer (C) as the correct answer. The petitioner argues that (D) is not the best answer, because the examiner will then make a 35 USC 103 rejection. Petitioner contends that it is not time and cost effective for the applicant to simply traverse the rejection because the examiner will write another office action and patent term is based on the filing date of the application. Therefore petitioner argues that (C) should also be given credit.

The petitioner's arguments have been fully considered but are not persuasive. Afternoon question 33 states that "the examiner rejects claim 1 under 35 U.S.C. § 35 U.S.C. § 102(d) as anticipated by [the Foreign patent]." It does not indicate that the rejection was made under § 103(a). A reply to a rejection under 35 U.S.C. § 103(a) is not required under 37 CFR 1.111(b), because the examiner did not make a rejection under 35 U.S.C. § 103(a). A reply to the rejection the examiner did make under 35 U.S.C. § 102(d) is required. Answer (C) is not the best answer because it does not address the rejection under 35 U.S.C. § 102(d) set forth by the examiner. Answer (D) is the best answer because it does address the grounds of rejection set forth by the examiner in the Office action.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, 1 point have/has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy